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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/825,083

04/14/2004

Mikhail M. Feldstein

2335-0010

7175

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7590

09/22/2006

MINTZ, LEVIN, COHN, FERRIS, GLOVSKY AND POPEO, P.C  
1400 PAGE MILL ROAD  
PALO ALTO, CA 94304-1124

EXAMINER

CHEUNG, WILLIAM K

ART UNIT

PAPER NUMBER

1713

DATE MAILED: 09/22/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/825,083

Applicant(s)

FELDSTEIN ET AL.

Examiner

William K. Cheung

Art Unit

1713

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 11 September 2006.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 24,26-30,38,40,91 and 92 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 24,26-30,38,40,91 and 92 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Request for Continued Examination***

1. The request filed on September 11, 2006 for a Request for Continued Examination (RCE) under 37 CFR 1.53(d) based on parent Application No. 10/825,083 is acceptable and a RCE has been established. An action on the RCE follows. Claims 24, 26-30, 38, 40, 91, 92 are examined with merit.

### ***Claim Rejections - 35 USC § 102***

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

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The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

3. Claims 24, 26-30, 38, 40, 91, 92 are rejected under 35 U.S.C. 102(e) as being anticipated by Parker et al. (US 2003/0055190 A1) for the reasons adequately set forth from paragraph 4 of non-final office of April 6, 2006.

Applicant's arguments filed September 11, 2006 have been fully considered but they are not persuasive.

Applicants argue that nowhere in Parker et al. teaches materials that are water soluble. However, the examiner disagrees because in view of the composition teachings in Parker et al. (page 1, 0006-0014), applicants must recognize that the disclosed formula I include an acrylic acid monomer esterified with a hydrophilic side chain. Applicants must recognize that the ethylene oxide units on the side chain of formula I is inherently water-soluble. Although applicants argue that the side chain formula I of Parker et al. also contain ethylene or propylene units that are inherently not water-soluble, applicants must recognize that the recited m can be as high as 1370 which is significantly larger value as compared to the recited n, which ranges from 9-115. In view

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of that the disclosed side chain can contain 99.3 mole percent of ethylene oxide units, the examiner has a reasonable basis that the side chain of the formula I of Parker et al. can impart water solubility to the disclosed materials.

Regarding applicants' argument that the recited "consisting essentially of" limits the scope of a claim to the specified materials or steps that do not materially affect the basic and novel characteristic(s) of the claimed invention, applicants must recognize that there is not a evidence that the basic properties (water solubility) of Parker et al. had been affected by less than one mole percent of alkylene units into the ethylene oxide side chain of Parker et al. Further, applicants must recognize that the recited "consisting essentially of" limits the scope of the claim not to contain other side chains that do not materially affect the basic and novel characteristic(s) of the claimed invention, not the composition of the side chain as claimed.

Regarding claims 38, 40, 91, 92 applicants argue that the claims as written require an oxygen, sulfur, amide, or  $-(CO)-S-$  moiety that is attached directly to the polymer backbone, applicants fail to recognize that  $L^1$  groups as written do not require the oxygen, sulfur to be directly attached to the polymer backbone. Therefore, the  $L^1$  groups as written can include the carbon of the recited functional groups to be directly attached to the polymer backbone.

**Conclusion**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to William K. Cheung whose telephone number is (571) 272-1097. The examiner can normally be reached on Monday-Friday 9:00AM to 2:00PM; 4:00PM to 8:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David WU can be reached on (571) 272-1114. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



William K. Cheung Ph.D.

Primary Examiner

**WILLIAM K. CHEUNG  
PRIMARY EXAMINER**

September 14, 2006